

Q 5

b. a computer program stored on said memory medium, said computer program comprising instructions for recording information from said customer in digital form, confirming whether a telephone of said customer is memory equipped, and sending said information from said seller to said customer for storage and use during a subsequent telephone purchase.

Please add new claims 18-20 as follows:

-- 18. Apparatus of claim 1 wherein the data interface, the card reader, the data memory, and key are integrated into the telephone set.--

Q 6

-- 19. Apparatus of claim 1 wherein said information comprises credit card information.--

-- 20. The method of claim 11 wherein said information comprises credit card information.- -

REMARKS

In response to the non-final Office Action dated February 11, 1998, claims 5, 11, 13, and 15-17 are amended, and claims 18-20 are added. Therefore, claims 1-20 are now active in this application.

CLAIMS OBJECTIONS

The claims were objected to for lacking proper introduction. In response, the claims have been amended so that the phrase "What is claimed is:" now appears before claim 1. It is therefore respectfully requested that the objection to the claims be withdrawn.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 103

Claims 13 and 15-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Weiss et al. (U.S. Patent No. 5,195,130). This rejection is respectfully traversed for the reasons which follow.

The invention of claim 13 recites a method of sending information related to a telephone purchase from a seller to a customer. The method comprises the steps of “recording information from said customer in digital form; ... determining whether a telephone of said customer is memory equipped; and ... sending said information from said seller to said memory equipped telephone of said customer for storage.” These steps allow the present invention to be used more effectively than currently existing systems since the present invention can be used not only with customers that use conventional telephone, but also with customers having modified telephones of the type disclosed in the present application. The use of the modified telephones allow the steps of “determining whether a telephone of said customer is memory equipped” and sending the recorded information for storage, to provide the unique advantages of the present invention. In this way, customer/seller transactions can be made more efficient by storing frequently used information which was previously required by a seller, and likely to be required by other sellers. None of the prior art, considered individually or in combination, teaches or suggests this newly recited aspect.

Weiss et al. disclose a computer and telephone apparatus that delivers data processing capabilities and services through an ordinary telephone instrument. The central computer of the Weiss et al. system has a session manager that “stores information relating

to the user of the terminal and the service computer system 60a-d which the user is accessing.” (column 25, lines 21-23).

However, Weiss et al. do not teach or suggest the claimed aspect of determining whether a telephone of said customer is memory equipped and sending information to that memory. This aspect is not considered to be obvious either since the operation of the Weiss et al. system stores information relating to the user and the service computer in the session manager 64 which is contained within the network host computer 60, not within any customer computer. Since there is no sending of recorded to the memory equipped telephone of the customer for storage, there is no teaching or suggestion for determining whether the telephone of the customer is memory equipped. It is these recited aspects which provide some of the advantages of the present invention over conventional systems such as that disclosed in Weiss et al. Specifically, the present invention allows the information, once determined by a seller to be acceptable, to be stored in the customer telephone for future use by the same or other sellers without having to input the information a second time. This helps ensure the numbers required for authorizing a sale are transmitted accurately and quickly, thus removing some disincentives to telephone transactions. Since the prior art fails to teach or suggest the claimed aspect quoted above, it is respectfully urged that claim 13 as amended is allowable.

Claim 15 now recites limitations similar to that argued above in support of the allowability of newly amended claim 13. Specifically, claim 15 recites “confirming whether a telephone of said customer is memory equipped” so that the “information stored in said seller memory” is sent to the customer memory “for use during a subsequent order.”

Claims 16 and 17 recite similar limitations, as well. These limitations are neither taught nor suggested by the prior art.

Claims 1-4, 11-12 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Weiss et al., and further in view of Rosen (U.S. Patent No. 5,455,407). This rejection is respectfully traversed for the reasons which follow.

Claim 1 recites “**a key** for activating said data memory to send said stored information”, where the information is defined in the claims as “**information from one of said called stations, including said card information.**” The Official Action does not address this limitation. After a thorough review of the prior art, none of the references, taken alone or in combination, teaches or suggests this aspect. Therefore, it is respectfully urged that claim 1 and all claims dependent thereon are allowable over the prior art.

It should be noted at this point that although Talton (U.S. Patent No. 5,452,352) was not applied against claim 1, Talton was cited against claim 5 (argued separately below) for teaching a key. However, Talton does not teach or suggest this aspect of claim 1 where the key controls the sending of information “from one of said called stations, including said card information”. Therefore, claim 1 is considered allowable over all cited art for at least the reasons stated above.

Claim 11 recites a method of sending information related to a telephone purchase from a customer to a seller. The method comprises the steps of “...storing information, including card information, received from a seller in memory located at a customer-site telephone; and ... subsequently sending said information from said memory located at the customer-site telephone to a seller.”

The Official Action concedes that Weiss et al. do "not disclose the sending of the information received from the called station to another called station", and relies on Rosen for this aspect. Rosen discloses an electronic monetary system which is interchangeable with conventional paper money. Participating financial institutions store electronic money and make on-line money exchanges with other institutions.

The Action states that it would have been obvious to "implement the sending of electronic notes as disclosed by Rosen as the method of payment for telephonic purchases in the system disclosed by Weiss because customers would not have to worry about having their credit card account numbers being intercepted by third parties or misused by sellers."

Firstly, there is no teaching or suggestion found in either reference for combining the computer/telephone of Weiss et al. with an electronic monetary system such as that disclosed in Rosen. It is well established that under 35 U.S.C. §103, teachings of references can be combined only if there is some suggestion or incentive to do so. Without the proper suggestion in the prior art, the references are not properly combinable. Here, the Action does not provide any support in the references for justifying this combination, and therefore it is respectfully asserted that the rejection is improper.

With respect to the rationale for combining the references stated in the Action, it appears that some sort of authorization number, similar to a credit card number, would be required to complete the electronic transfers of Rosen. These authorization numbers would appear to be equally susceptible to the interception or misuse identified in the Action, and thus would not provide sufficient motivation for combining the references for this reason.

Secondly, the suggested modification of these references as proposed by the Official Action does not render the claimed invention obvious. The Office Action states that Rosen

discloses that the transaction memory module can be embodied as a co-processor in a telephone connected to a network (col. 9, lines 60-65). While Rosen may be said to disclose a co-processor in a telephone, this modification does not result in the invention as recited in claim 11. Claim 11 specifically recites "storing information, including card information, received from a seller in a memory which requires "sending said information from said memory located at the customer-site telephone to a seller". The resultant modification would not anticipate, or render obvious, the invention recited in claim 11. Therefore, it is urged that claim 11, and dependent claim 12 are allowable over the prior art.

Claim 14 is considered allowable for at least those reasons provided above in support of parent claim 13.

Claims 5-10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Talton (U.S. Patent No. 5,452,352), and further in view of Weiss et al. This rejection is respectfully traversed for the reasons which follow.

Claim 5 recites a portable device for sending information to called stations over a telephone line. The portable device comprises "a docking port for receiving information from an external memory and loading said information into said device memory, wherein said information comprises card information relating to a telephone purchase and is received from a seller memory connectable to said external memory". Neither Talton or Weiss et al. teach or suggest this aspect. As mentioned above, Weiss et al. do not teach or suggest receiving information from a seller memory. Talton does not teach or suggest this newly recited limitation either. Therefore, it is urged that claims 5-10 are allowable over the prior art for at least the reasons in support of independent claim 5.

For the reasons stated above, the rejection of claims 1-17 under 35 U.S.C. §103(a) should be reconsidered and withdrawn. The remaining references which were cited but not applied have been reviewed, but are not believed to be pertinent to the patentability of the present invention.

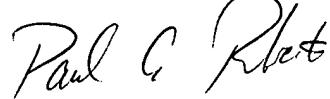
CONCLUSION

Accordingly, it is urged that all claims currently pending patentably distinguish over the prior art and the application is in condition for allowance. Favorable reconsideration is respectfully requested. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Paul A. Roberts
Registration No. 40,289

99 Canal Center Plaza, Suite 300
Alexandria, Virginia 22314
(703) 518-5100 PAR:PAR
Facsimile: 703-684-1124
Date: May 11, 1998